

REMARKS

In the Office Action, the Examiner rejected claims 1-94. By this paper, Applicants added new claims 95-109, and amended claims 1, 2, 5, 7, 31-36, 38, 41, 51, and 79 for clarification of certain features to expedite allowance of the present application. These amendments do not add any new matter. Upon entry of these amendments, claims 1-109 remain pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Claim Rejections under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 31, 32, and 48 under 35 U.S.C. § 112, Second Paragraph, for being indefinite for failure to point out what is included or excluded by the claim language. More particularly, the Examiner contends that these claims are omnibus type claims. Applicants respectfully traverse this rejection.

Omnibus type claims are properly rejected as indefinite under 35 U.S.C. § 112, Second Paragraph. *See, e.g., Ex parte Fressola*, 27 U.S.P.Q.2d 1608 (Bd. Pat. App. & Inter. 1993); M.P.E.P. § 2173.05(r). However, the Examiner is incorrect in asserting that claims 31, 32, and 48 of the present application are such omnibus claims. Omnibus claims are claims that “define the invention entirely by reference to the specification and/or drawings.” *Ex parte Fressola*, 27 U.S.P.Q.2d at 1609. Further, in *Fressola*, the Board stated that an omnibus claim does not satisfy Section 112, Second Paragraph, “because the claim does not itself define the invention, but relies on external material” (such as the specification or drawings). *Id.* at 1613.

Conversely, the present claims clearly point out what is included or excluded by the claim language. Each claim depends from either independent claim 1 or 33, and incorporates the elements of these independent claims. Contrary to the claim at issue in

Fressola, the present claims do not rely on any external material in defining their scope. Consequently, claims 31, 32, and 48 are not omnibus type claims as suggested by the Examiner, and satisfy the requirements of 35 U.S.C. § 112, Second Paragraph. Accordingly, Applicants respectfully request withdrawal of the rejection under Section 112, Second Paragraph and allowance of these claims.

Claim Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1, 2, 4-6, 11-23, 25-27, 30, 33, 35, 36, 41-47, 49-53, 59-69, 75-80, 83-85, and 89-93 under 35 U.S.C. § 102(e) as anticipated by Reichmeyer et al. (U.S. Patent No. 6,286,038). Applicants respectfully traverse this rejection.

Legal Precedent

First, Applicants remind the Examiner that, during patent examination, the pending claims must be given an interpretation that is reasonable and consistent with the specification. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969); see also *In re Morris*, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); see also M.P.E.P. §§ 608.01(o) and 2111. Interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. See *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); see also M.P.E.P. § 2111. As further explained in Section 2111.01 of the M.P.E.P., the words of the claim must be given their plain meaning unless the applicant has provided a clear definition in the specification. See *In re Zletz*, 893 F.2d 319, 321, 13 U.S.P.Q.2d 1320, 1322 (Fed. Cir. 1989). Again, the plain meaning refers to an interpretation by those of ordinary skill in the art. See *In re Sneed*, 710 F.2d 1544, 218 U.S.P.Q. 385 (Fed. Cir. 1983).

Second, anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227

U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the . . . claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Claim Features of Independent Claim 1 Omitted from the Cited Reference

Turning to the claims, independent claim 1 recites elements not present in the Reichmeyer et al. reference. Among its recitations, amended claim 1 recites a method including acts of “actively electronically discovering a computing device coupled to a network; identifying the computing device; and configuring network parameters of the computing device based on the identification.”

The Reichmeyer et al. reference fails to disclose all of these features of claim 1. While one of the passages relied upon by the Examiner does discuss “neighbor discovery,” this technique does not teach the recited elements of independent claim 1. The reference teaches that a network device may obtain some information regarding its connectivity by learning about other, nearby, devices on the network. Col. 7, lines 14-22. However, the “neighbor discovery” process of Reichmeyer et al. does not *configure* these *neighboring* devices. Instead, *it is the device performing the “neighbor discovery”* that is configured. See col. 6, lines 24-42. Thus, the “neighbor discovery” procedure outlined by the Reichmeyer et al. reference fails to disclose each and every element of independent claim 1.

Unfortunately, though the Examiner did point to two passages of the Reichmeyer et al. reference in support of his rejection of claim 1, the Examiner failed to particularly point out which structure or procedures present in the reference support the rejection. Claim 1, prior to the present amendment, recited “electronically locating a computing device coupled to a network.” Upon review of the reference, it is unclear whether the Examiner believed configuration server 26 performed such an act. Though Applicants believe such reasoning would be incorrect, Applicants note that the amendment of claim 1 renders the issue moot. As provided above, independent claim 1 now recites “actively electronically discovering a computing device coupled to a network.” Applicants further note that the configuration server of the Reichmeyer et al. reference does not perform any discovery and merely passively receives information transmitted by a device awaiting configuration. *See* col. 1, lines 26-47; col. 6, lines 24-31. Consequently, because Reichmeyer et al. reference fails to disclose each and every element, Applicants believe independent claim 1 to be allowable over the Reichmeyer et al. reference.

Claim Features of Independent Claim 33 Omitted from the Cited Reference

Independent claim 33, as amended, recites a method including acts of “electronically searching to identify the presence and location of a desired device on a network; and remotely configuring operational parameters of the desired device via the network.”

The Reichmeyer et al. reference relied upon by the Examiner fails to teach every element recited in claim 33. As discussed above with respect to claim 1, the configuration server does not *search* for a desired device; it waits passively to receive information from the device and then sends configuration information. Col. 6, lines 24-42; *see* FIGS. 4-6. Also as discussed immediately above, the “neighbor discovery” procedure does not lead to configuration of the neighboring devices. Because of these

omitted elements, independent claim 33 is also not anticipated by the Reichmeyer et al. reference.

Claim Features of Independent Claim 51 Omitted from the Cited Reference

Similarly, the Reichmeyer et al. reference also fails to disclose each element of independent claim 51. Claim 51 recites, in part, “a device discovery assembly adapted for actively discovering the second computing device on the network.”

The Reichmeyer et al. reference fails to teach each element of claim 51. For instance, the Reichmeyer et al. reference discloses obtaining information from *already known* devices, rather than *discovering the devices* as set forth in claim 51. The Examiner relied on a particular passage of Reichmeyer et al. reference as disclosing these elements. *See* col. 4, line 51 – col. 5, line 10. However, this rejection is based on a mischaracterization of the cited passage and reference. The Reichmeyer et al. reference teaches a central management system 24 having a configuration server 26 coupled to a topology database 28. Col. 4, lines 53-55. The topology database is used to store and retrieve information relating to the physical and logical topology of network 22. Col. 4, lines 56-58. The Reichmeyer et al. reference discloses that a *physical topology discovery* protocol may be used to collect information from physical topology management information bases (MIBs) on *known* network devices. Col. 4, line 66 – col. 5, line 3. However, *physical topology* discovery is not the same as *device* discovery. The latter may be used to actually discover devices previously unknown, whereas the former is used to discover physical connectivity of devices that have themselves already been discovered. *See* col. 5, line 60 – col. 6, line 23. Thus, the physical topology discovery protocol does not disclose “a *device* discovery assembly adapted for actively discovering the second computing device on the network” (emphasis added) as recited by claim 51. Accordingly, Applicants request withdrawal of the Examiner’s rejection and allowance of independent claim 51.

Claim Features of Independent Claim 79 Omitted from the Cited Reference

Finally, the Reichmeyer et al. reference also fails to disclose each element of independent claim 79. Claim 79 recites, among other things, “a device identification module adapted to search for and identify the presence and location of the desired device based on desired parameters.”

Similar to the discussion above regarding claim 51, because the presence of the device having a physical topology MIB is already known, the physical topology discovery protocol cannot be reasonably compared with “a device identification module adapted to *search for and identify the presence* and location of the desired device based on desired parameters” (emphasis added) as recited in claim 79. In the Reichmeyer et al. reference, the physical topology discovery protocol merely obtains device information from *known* network devices. It does not “search for and identify the presence and location of the network devices” as recited by independent claim 79. Because the Reichmeyer et al. reference fails to disclose each element of independent claim 79, the claim is believed to be allowable over the Reichmeyer et al. reference.

For these reasons, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 102.

Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 24, 54-57, 58, 81, and 82 under 35 U.S.C. § 103(a) as obvious over the Reichmeyer et al. reference in view of Li et al. (U.S. Patent No. 6,012,088); claims 3, 7, 9, 10, 34, 38, 40, 70, 71, 73, 74, 86, 88, and 94 under 35 U.S.C. § 103(a) as obvious over the Reichmeyer et al. reference in view of Caswell et al. (U.S. Patent No. 6,336,138); claims 8, 39, 72, and 87 under 35 U.S.C. § 103(a) as obvious over the Reichmeyer et al. reference in view of the Caswell et al. reference in further view of Morisada et al. (EP 0964546 A2); claims 28 and 29 under 35 U.S.C. § 103(a) as obvious over the Reichmeyer et al. reference in view of Tonelli et al. (U.S. Patent No. 6,229,540);

and claim 37 under 35 U.S.C. § 103(a) as obvious over the Reichmeyer et al. reference in view of Pike et al. (U.S. Patent No. 6,721,880).

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

Deficiencies of Rejection

As discussed above, the Reichmeyer et al. reference fails to disclose each element of independent claims 1, 33, 51, and 79. The Li et al., Caswell et al., Morisada et al., Tonelli et al., and Pike references fail to obviate the deficiencies of the Reichmeyer et al. reference. Accordingly, dependent claims 3, 7-10, 24, 28, 29, 34, 37-40, 54-58, 70-74, 81, 82, 86-88, and 94 are allowable on the basis of their dependency from a respective allowable independent claim 1, 33, 51, and 79, as well as for the subject matter recited by each dependent claim. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of these dependent claims.

New Claims

As discussed above, new claims 95-109 have been added by the present Response. These claims add no new subject matter, are fully supported by the specification, and clearly contain subject matter not disclosed by the references cited by the Examiner. Accordingly, Applicants request allowance of these newly added claims.

Conclusion


Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Authorization for Extensions of Time and Payment of Fees

In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request thereof. The Commissioner is authorized to charge the requisite fee of \$358.00 for additional claims, and any additional fees which may be required, to Deposit Account No. 08-2025; Order No. 200302131-1/FLE/SWA.

Respectfully submitted,

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